PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

In Re Application of:	
Rodriguez, et al.	Group Art Unit: 2623
	Examiner: Ustaris, Joseph G.
Serial No.: 09/896,231	
	Confirmation No. 9416
Filed: June 29, 2001	
	Docket No.: A-7259 (191910-1870)
For: Bandwidth Allocation and Pricing System for Downloadable Media Content	

REPLY BRIEF RESPONSIVE TO EXAMINER'S ANSWER

Mail Stop Appeal Brief - Patents
Commissioner of Patents and Trademarks
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

The Examiner's Answer mailed November 30, 2006 has been carefully considered. In response thereto, please consider the following remarks.

It is not believed that additional extensions of time or fees are required to consider this Reply Brief. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor are hereby authorized to be charged to Deposit Account 20-0078.

REMARKS

In the Examiner's Answer, the Examiner has provided various responses to arguments contained in Applicants' Appeal Brief. Applicants address selected responses in the following.

A. Meaning of "Recordable Content"

The claim term "recordable content," used in all the independent claims, is at issue. A selected portion of exemplary claim 1 is reproduced below, with the disputed language emphasized:

> a first memory; and
> a first processor configured with the first memory to ***download recordable media content*** at one of a plurality of various download times for purchase of the recordable media content, wherein the processor uses reallocated excess on-demand infrastructure capacity.

In the Examiner's Answer, the Examiner alleges that his interpretation of "recordable media content" covers all video and related media:

> Rodriguez does disclose the use of "recordable content." Throughout the reference, Rodriguez makes references to video and related media. The Examiner interprets video as encompassing "recordable content." This logic is founded on the reasoning that, because video can be recorded – it is "recordable." Accordingly, Rodriguez teaches all limitations of Claim 1. (Examiner's Answer, p. 27, Section 10.)

Applicants respectfully submits that this reasoning is clear error. The Examiner has interpreted a term to be anticipated by a reference even though that reference teaches away from such an interpretation. Video and media content is only recordable ***in a system*** if the system is configured to record the video. If the system is set up such that the video is not recordable, if the reference teaches away from enabling the recording of the video, then ***the video is not recordable to that system***. The Examiner "must consider the reference in its entirety, and cannot ignore those portions of the reference that argue against obviousness."

See W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1550 (Fed. Cir. 1983) *cert. denied.*

The Examiner has ignored the fact that the Rodriguez reference teaches away from the video content being recordable. The Supreme Court has held that "teaching away" from the claimed invention by the prior art is an important indicium of anticipation. *U.S. v. Adams*, 383 U.S. 39, (1966). Such teaching away should be weighed heavily in determining the interpretation of the claim term and the anticipation of the independent claims.

Applicant respectfully submits that the interpretation offered by Applicant, in which "recordable media content" is interpreted in light of the cited reference, makes the claims patentable over the cited reference and, for at least this reason, the rejection should be withdrawn and the claims should be allowed.

B. Meaning of "Reallocated Excess On-Demand Infrastructure Capacity"

The claim term "recordable content," used in all the independent claims, is at issue. A selected portion of exemplary claim 1 is reproduced below, with the disputed language emphasized:

> a first memory; and
> a first processor configured with the first memory to download recordable media content at one of a plurality of various download times for purchase of the recordable media content, wherein ***the processor uses reallocated excess on-demand infrastructure capacity***.

In the Examiner's Answer, the Examiner alleges that the cited reference discloses this limitation:

> Rodriguez discloses that the system manages bandwidth and RF channel allocation by allocating bandwidth adaptively according to demand. ... [Also,] Haddad discloses that the system is capable of distributing the multimedia data at various times, such as off-peak hours, to more efficiently utilize the system hardware. ... Instead of using the bandwidth during peak hours, the system of Haddad can reallocate that bandwidth to be used during off-peak hours, where there will be lower demand because of extra, or excess, bandwidth. Since the

> system of Haddad operates dynamically (i.e., user's [sic] can request video at anytime), the system is constantly allocating and reallocating bandwidth.

However, neither reference refers to reallocating excess on-demand infrastructure capacity. The Examiner alleges that the systems could perform this function. However, the legal question is not whether the system could be operated in this manner. Instead the legal question is whether the reference discloses, teaches, or suggests all elements/features of the claim at issue. See, e.g., E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co., 849 F.2d 1430, 7 U.S.P.Q.2d 1129 (Fed. Cir. 1988). Neither Rodriguez nor Haddad does so. For at least this reason, the rejection should be withdrawn and the claims should be allowed.

CONCLUSION

Based upon the foregoing discussion, Applicants respectfully request that the Examiner's final rejection of claims 1-74 be overruled and withdrawn by the Board, and that the application be allowed to issue as a patent with all pending claims.

Respectfully submitted,

/BAB/

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